

REMARKS

The Official Action dated April 15, 2003 has been received and carefully noted. The following remarks are submitted as a full and complete response thereto. Claims 22 – 42 are respectfully submitted for consideration.

The following prior art rejections were made in the outstanding Office Action:

Claims 22 – 33, 36, 37, 39, 40 and 41 were rejected under 35 USC §102(e) as being anticipated by Lintulampi (United States Patent No. 6,337,804).

Claims 34 and 35 were rejected under 35 USC §103(a) as being unpatentable over Lintulampi, and further in view of Grube (WO 95/24809).

Claims 38 and 42 were rejected under 35 USC §103(a) as being unpatentable over Lintulampi in view of Karmi (United States Patent No. 5,884,157).

As will be discussed below, applicants respectfully submit that each of the presently pending claims 22 – 42 recite subject matter which is neither disclosed nor suggested in the cited prior art.

Independent claim 22, upon which claims 23 – 39 are dependent, recites a method of interworking between different radio access networks comprising a radio transceiver device capable of operating with a first radio access network and a second radio access network being attached to the first radio access network. The method comprises the steps of detecting a service request, wherein the service request is received from the network side. Information is accessed on conditions where the first and second radio access networks for giving sufficient support for a service requested by the service request. It is

then analyzed whether or not the first radio access network and the second radio access network meets the conditions. A handover of the radio transceiver device is initiated from the first radio access network to the second radio access network if the second radio access network meets the conditions but the first radio access network does not.

Claim 39, upon which claims 40 – 42 are dependent, is directed to a network interworking device for a telecommunication network comprising at least 2 radio access networks. A radio transceiver device is capable of operating with the first radio access network and the second radio access network is attached to the first radio access network. The device comprises a detecting means for detecting a service request, wherein the service request is received from the network side. An analyzing means is responsive to the detecting means, and has the functionality of accessing information on conditions for the first and second radio access networks for giving sufficient support for the service requested by the service request. The analyzing means also analyzes whether or not the first radio access network and the second radio access network meet the conditions. Initiating means are responsive to the analyzing means, with the initiating means being adapted to initiate a handover of the radio transceiver device from the first radio access network to the second radio access network if the respective conditions are not met by the first radio access network but by the second radio access network.

As a result of the claimed configurations, a number of critical and unobvious advantages are provided. For example, a situation can be handled in which a service is provided which is not supported by a currently used radio access network, but by a

different radio access network. This is achieved by effecting a handover from the first to the second radio access network. Additionally, it is possible to initiate a handover in a situation where a service is more sufficiently supported by the second radio access network than by the first radio access network. In other words, the present invention provides more flexible usability of mobile stations. Applicants respectfully submit that the cited prior art fails to disclose or suggest the elements of the claimed invention, and therefore fails to provide the critical and unobvious advantages which are discussed above.

As a preliminary matter, with respect to the rejections under 35 U.S.C. §103, applicant's respectfully submit that these rejections should be withdrawn since Lintulampi is not a proper reference under 35 U.S.C. §103(c). Lintulampi is assigned to Nokia Mobile Phones Limited, of Espoo, Finland. The present application is assigned to Nokia Networks OY, of Espoo, Finland. Applicants respectfully submit that Nokia Mobile Phones and Nokia Networks are both wholly owned business units of Nokia Corporation. Attached is a printout from the Nokia Corporation home page, located at www.nokia.com/nokia/0,8764,33080,00.html which explains that Nokia Corporation includes two business groups, those being Nokia Mobile Phones and Nokia Networks. Therefore, as indicated in 35 U.S.C. §103(c), Lintulampi cannot be used as prior art in making a rejection under 35 U.S.C. §103(a); 35 U.S.C. §103(c) clearly explains that subject matter developed by another person, which qualifies as prior art only under 35 U.S.C. §102(e), (f) or (g), shall not preclude patentability under 35 U.S.C. § 103 where

the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Lintulampi and the present invention are both owned by Nokia Corporation, and it is respectfully submitted that the rejections under 35 U.S.C. § 103(a) are improper.

With respect to the anticipation rejection of claims 22 – 33, 36, 39, 40 and 41, it is respectfully submitted that Lintulampi fails to disclose each and every element of these claims. Applicants note that the US Patent to Lintulampi is the US equivalent of WIPO Publication WO 98/59513, which was considered by the International Examining Authority during the international phase of the PCT application from which the present application originates. While applicants note that determinations of the International Examining Authority are not binding on the U.S. Patent and Trademark office, the PCT Examining Authority determined that the claims recited subject matter which was patentable over the teachings of Lintulampi. Lintulampi discloses a method of operating a dual mode mobile telephone. In particular, Lintulampi discloses a method of control a mobile originated connections in a system comprises at least two networks. The service request is analyzed , and if the network that the mobile is currently roaming does not support the service requested, the registration of the mobile station is moved to the other network. The registration can be moved by the mobile station sending a service request to the second network, or by handing the signaling connection over to the second network. However, Lintulampi only describes a mobile terminating case, as illustrated in Figures 4a and 5a. In other words, relating to Figure 3 of Lintulampi, for example, the

mobile station itself checks whether the radio access network to which the mobile station is currently connected can support a service or not. However, there is no disclosure nor suggestion in Lintulampi regarding how to handle a service request which is received from outside the radio access network. Lintulampi makes no mention of any situation wherein service requests may also occur in the direction from the network side to the mobile station. According to the teachings of Lintulampi, therefore, it is not possible to receive a service request from the network side. A person of skill in the art, therefore, would not be able to determine from Lintulampi any method or apparatus which would yield the subject matter of presently pending independent claims 22 and 39, and/or any claims dependent thereupon. It is respectfully but strongly urged that Lintulampi, therefore, fails to disclose or suggest any step which could be considered to be comparable to detecting a service request which is received from the network side. Therefore, there is no disclosure or suggestion of any method which can access, analyze or initiate the recited elements of any of the presently pending method claims. Similarly, with respect to apparatus claims 39 – 42, there is no disclosure nor suggestion of any type of detecting means for detecting a service request which is received from the network side, and therefore, no disclosure nor suggestion of any analyzing means or initiating means as recited in the system claims.

As discussed above, therefore, it is specially requested that the anticipation rejections over Lintulampi be withdrawn.

With respect to the obvious rejections under 35 U.S.C. § 103, applications

respectfully submit that Lintulampi can not be properly considered to be a reference due to the common ownership of Lintulampi and the present invention. It is further submitted, however, that the prior art of Grube and/or Karmi fails to cure the significant deficiencies of Lintulampi with respect to the dependent claims. Claims 34 and 35 recite subject matter which is neither disclosed nor suggested in the combination of Lintulampi and Grube, and claims 38 and 42 recite subject matter which is neither disclosed nor suggested by a combination of Lintulampi and Karmi.

Grube discloses a method for providing alternate communication services based upon geographic location. In Grube, it is determined whether a particular service requested is prohibited in a predefined area. If so, an alternative service is made available to the requesting user identity (See Figure 2 of Grube). If there is not availability of any such alternative service, an error message is issued as illustrated in Figure 210. However, there is no disclosure nor suggestion in Grube of a handover being automatically preformed. A person skilled in the art, therefore, would not be able to determine how to yield the claimed invention based upon a combination of Lintulampi and Grube.

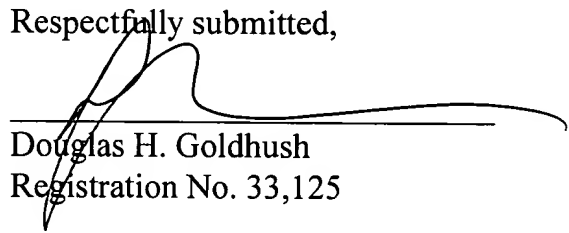
Karmi discloses that a check is performed in order to determine whether a particular user is entitled to use a particular service. However, there is no disclosure nor suggestion in Karmi when viewed alone, or Karmi when combined with Lintulampi, of how to perform a handover between 2 different networks in case a service is not available in one of the networks. Therefore, a person with ordinary skill in the art would not be able to yield the claimed invention based upon a combination of Lintulampi and Karmi.

In view of the above, applicants respectfully submit that each of the presently pending claims recite subject matter which is neither disclosed nor suggested in the cited prior art. Applicants further submit, as noted above, that the obviousness rejections of claims 34, 35, 38 and 42 be withdrawn due to the fact that Lintulampi can not be used as a reference under 35 U.S.C. §103. It is therefore respectfully submitted requested that claims 22 – 42 be found allowable, and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applications undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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